

Application No.: 10/743,305

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REMARKS

Applicants have carefully considered the November 14, 2006 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance.

Claims 1-17 and 19-20 were pending in this application. In response to the Office Action dated November 14, 2006, claims 1 and 19 have been amended and claim 15 has been cancelled. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-14 were rejected under 35 U.S.C. § 102(a) as being anticipated by Jones et al. (U.S. Pat. App. Pub. No. 2004/0153408, hereinafter "Jones"). Applicants respectfully traverse.

The present claimed subject matter, as described in each of independent claims 1, 5, 7 and 10-13, recites a banknote handling device comprising, inter alia, a counterfeit processing module that stores each banknote determined as counterfeit into the counterfeit collection box and prohibits the stored counterfeit banknote from being returned to the customer. The independent claims further require a notification module that notifies the customer of predetermined kind of information. The information provided for the customer, in the notification, is indicative of a total amount of money received from the customer and is

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indicative of an amount of money settled as a transaction; regardless of the result of the counterfeit detection by the discrimination module. Thus, the two features of the present claimed subject matter are summarized as follows: (a) a counterfeit banknote is recovered into a counterfeit collection box and is not returned to a customer; and (b) the customer is notified of information for specifying a total amount of money received from the customer, including any received counterfeit banknotes.

Independent claim 1 has been amended to further clarify an aspect already believed present in the claim, that is, the customer is notified of the total amount of money, which includes any counterfeit notes received from the customer as well as genuine notes. As described in the specification, the customer is notified of the amount of received counterfeit banknotes, as well as genuine banknotes, otherwise, the customer would be confused by a display that indicates a total amount of received genuine banknotes, especially since the devices of the present claimed subject matter do not return the counterfeit banknotes.

In contrast to the various recitations of independent claims 1, 5, 7 and 10-13, Jones, at numbered paragraph [0013] and step 236 in Fig. 11a, discloses that only genuine banknotes, not counterfeit banknotes, are counted and that the total amount  $B_{total}$  is the total amount of the genuine banknotes. Jones does not present a total amount including both genuine and counterfeit banknotes as required in each of independent claims 1, 5, 7 and 10-13.

Accordingly, Jones fails to disclose or remotely suggest every limitation of independent claims 1, 5, 7 and 10-13. As such, the rejection under 35 U.S.C. § 102 predicated upon Jones is not legally viable.

Claims 15 and 19 were rejected under 35 U.S.C. § 102(a) as being anticipated by Graef et al. (U.S. Pat. No. 6,983,880, hereinafter "Graef"). Applicants respectfully traverse.

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Claim 15 has been cancelled and dependent claim 19 has been recast in independent form to include the subject matter of claim 15.

Independent claim 19 describes a banknote handling device that handles banknotes. The banknote handling device comprises, in pertinent part, a management module that manages customer information for identifying each customer who handles a transaction, mapped to the presence or absence of any counterfeit banknote involved in the transaction, wherein the management module maps each banknote involved in the transaction to the customer information. The Examiner asserted that Graef discloses these features at column 23, lines 14-32.

Applicants submit that Graef discloses that the unacceptable sheets in the storage area 100 must be recovered for purposes of tracing the sheets to the user who placed them in the machine. However, Applicants submit that Graef does not identically disclose "managing customer information for identifying each customer", as required in claim 19.

Graef specifically discloses providing one or more outputs such as through a screen or a printer indicating the transactions and/or users which correspond to the suspect sheets, and storing such data in the machine. See column 24, lines 27-67. However, it is believed that these descriptions were not included in the specification of Graef's provisional application and were only added on April 7, 2004, after the filing date of the subject application in the U.S. (December 23, 2003), and, therefore, the Graef patent does not constitute prior art to the subject application. It is the Examiner's initial burden to demonstrate where the Graef patent discloses the claimed limitation, prior to the U.S. filing date of the present application.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(a) predicated upon Graef are solicited.

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Independent claim 16 and dependent claim 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Graef in view of Hallowell et al. (U.S. Pat. App. Pub. No. 2004/0003980, hereinafter "Hallowell"). Applicants respectfully traverse.

Independent claim 16 describes a banknote handling device that handles banknotes. The banknote handling device includes, inter alia, that at least one of the multiple banknote storage boxes in the safe is set to a counterfeit collection box and which stores each banknote determined as counterfeit (by the discrimination module) and each counterfeit banknote is not to be returned to the customer.

The Examiner asserted that independent claim 16 and dependent claim 20 are obvious from the combination of Graef and Hallowell. The Examiner stated that Graef discloses a safe, but admitted that Graef fails to disclose that at least one of the multiple banknote storage boxes in the safe is set to a counterfeit collection box. Nevertheless, the Examiner asserted that Hallowell discloses that one of storage boxes is set to a counterfeit collection box.

Hallowell discloses assigning output receptacles 106a-106h (corresponding to the storage boxes) in a currency handling device, and specifically assigns the upper output receptacle to a reject pocket, the output receptacle 106b to suspect bills, and the output receptacles 106c-106h to respective denominations of bills. See Hallowell at numbered paragraph [0081].

Applicants submit that Hallowell does not teach or suggest a money safe. In Hallowell, the output receptacle 106b for suspect bills is exposed to the outside of the device as described in Paragraph [0081] and disclosed in Fig. 1b. In addition, the transport mechanism 104 is stopped if an unidentified bill is presented (flagged) as described Paragraph [0082], and then the device continues operation when the flagged bill is removed as described in Paragraph [0084]. Specifically, in Hallowell, since the flagged bill must be removed to resume the operation of the

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device, the output receptacle 106b is exposed to the outside of the device, so that the customer is free to remove a bill transported to the output receptacle 106b (that is, the bill is returnable to the customer). Therefore, the feature of claim 16 that requires the counterfeit bill to be stored and not returnable to the customer, is not disclosed or suggested in Graef or Hallowell.

Dependent claim 20, which depends from claim 16, describes that the management module maps each banknote involved in the transaction to the customer information. As noted previously with respect to claim 19, Graef discloses that the unacceptable sheets in the storage area 100 must be recovered for purposes of tracing the sheets to the user who placed them in the machine. However, Applicants again submit that Graef does not identically disclose "managing customer information for identifying each customer" as required in claim 20. Graef specifically discloses providing one or more outputs such as through a screen or a printer indicating the transactions and/or users which correspond to the suspect sheets, and storing such data in the machine. See column 24, lines 27-67. However, it is believed that these descriptions were not included in the specification of Graef's provisional application and were only added on April 7, 2004, after the filing date of the subject application in the U.S. (December 23, 2003), and, therefore, the Graef patent does not constitute prior art to the subject application. Accordingly, dependent claim 20 is free from the applied art since Graef is not prior art, and neither Graef alone or in combination with the secondary reference to Hallowell teaches every limitation of claim 20. It is the Examiner's initial burden to demonstrate where the Graef patent discloses the claimed limitation, prior to the U.S. filing date of the present application.

Dependent claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Graef in view of Hallowell and further in view of Jones. Applicants respectfully traverse.

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Claim 17 is dependent on claim 16, and recites that the control module, when a bundle of banknotes received for one transaction includes any banknote determined as counterfeit, collectively stores the bundle of banknotes including both genuine and counterfeit banknotes in the counterfeit collection box.

The Examiner stated that Graef and Hallowell do not disclose the above-mentioned feature, but Jones teaches collectively storing genuine and counterfeit bills for one transaction in order to isolate all bills received from a customer who has put a counterfeit bill in.

Although the Examiner does not specifically indicate the section of Jones teaching the above feature, Jones discloses the device including only one storage box, since Jones discloses that a single canister is used for all documents in the stack, regardless of whether they are verified bills, no reads, or counterfeit suspects. See numbered paragraph [0113]; step 233 of Fig. 11a, and numbered paragraph [0114] concerning "single canister system". Therefore, unlike Claim 17 of the subject application, Jones does not disclose storing bills in a storage box other than a counterfeit storage box when no counterfeit bill is presented, and collectively storing both genuine and counterfeit bills in a counterfeit storage box when any counterfeit bill is presented. Accordingly, the rejection under 35 U.S.C. 103 predicated upon the combination of Graef, Hallowell and Jones, is not legally viable and should be withdrawn.

It is believed that the pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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